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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,043	06/15/2001	Guenter Jokschas	178/50052	5173

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EXAMINER

OCAMPO, MARIANNE S

ART UNIT PAPER NUMBER

1723

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/881,043	JOKSCHAS ET AL.	
	Examiner	Art Unit	
	Marianne S. Ocampo	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5-6</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 – 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a filter having a liquid level sensor probe, does not reasonably provide enablement for **just any other functional equipment or part**, other than a liquid level sensor probe or a suction tube, such as a heater or cooler or a magnetic device or other types of equipment can be used with a filter. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Claim 1 seemed to imply and claim that the claimed invention includes any functional part, but this is not true. Only a liquid level sensor and/or a suction tube of a liquid discharge are fully supported by the specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 recites the limitation "said cover" in line 3. Is it referring to the housing cover or another cover/structure which can act as a cover being added as limitation in this claim?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1 – 4, 9 - 10 and 12 are rejected under 35 U.S.C. 102(e) and (a) as being anticipated by Glebovsky et al. (US 5,520,800).

7. With respect to claim 1, Glebovsky et al. disclose a filter comprising a filter housing (1) with an inlet (3) and an outlet (4) for a fluid to be filtered, a filter cartridge (7, 10) arranged within the housing (1) so that the fluid from the inlet (3) must flow through the filter cartridge to reach the outlet (4) and further comprising at least one additional functional part (alkaline coated metal rods, 8), the filter cartridge comprising an annularly constructed filter medium (7) arranged between two axial end plates, and wherein the filter medium(7) is provided with at least one lateral recess (in the vicinity of the rods and between pleats) for accommodating the additional functional parts (8) of the filter, as in figs. 1 – 2 and cols. 3 - 4. Here the examiner has defined “functional part” being any mechanical part or structure which can performed another function other than filtering.

8. With regards to claim 2, Glebovsky et al. also disclose the filter medium (7) comprising a folded sheet of filter material with lateral edges joined to form a tubular structure, as in figs. 1 – 2.

9. Concerning claim 3, Glebovsky et al. further disclose the sheet of filter material (7) being folded in a zig-zag fashion to form a pleated structure, as in fig. 2.

10. Regarding claim 4, Glebovsky et al. disclose the lateral recess(es) being a folded pocket/space formed by an enlarged distance between adjacent folds/pleats, as in fig. 2.

11. With respect to claim 9, Glebovsky et al. also disclose the filter being a fuel (oil) filter for an internal combustion engine, as in cols. 1 – 2.

12. Concerning claim 10, Glebovsky et al. disclose a filter cartridge comprising an annularly constructed filter medium (7) arranged between two axial end plates and the filter medium (7) is provided with at least one lateral recess for accommodating a functional part (8) of a filter in which the filter cartridge is to be installed, as in figs. 1 – 2 and cols. 3 – 4.

13. With regards to claim 12, Glebovsky et al. further disclose the filter medium (7) being a pleated filter sheet and the lateral recess being a pocket/space formed by an enlarged distance or spacing between two adjacent pleats, as in fig. 2.

14. Claims 1, 5, 8 and 10 - 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Pennebaker (US 2,103,434).

15. Regarding claim 1, Pennebaker discloses a filter comprising a filter housing (1) with an inlet (3) and an outlet (4) for a fluid to be filtered, a filter cartridge (8, 10, 12) arranged within the housing (1) so that the fluid from the inlet (3) must flow through the filter cartridge to reach the outlet (4) and an additional functional part (14, 16), and the filter cartridge comprising an annularly constructed filter medium (12, 10, 8) arranged between two axial end plates (6, 7) and the filter medium (12) of the cartridge is provided with a lateral recess (at least one on the left and bottom end thereof) for accommodating a bottom/lower end (16) of the additional functional part (14, 16) of the filter, as in fig. 1 and pages 1 – 2.

16. Concerning claim 5, Pennebaker also discloses the lateral recess in the filter medium (12) of the cartridge extending axially at least to one of the end plates (7) of the cartridge and the one end plate (7) being provided with a notch (in which the terminal 16 is positioned thereon) which registers with the lateral recess in the filter medium (12), as in fig. 1.

17. Regarding claim 8, Pennebaker also discloses the housing (1, 2) comprising a housing cup (1) and a housing cover (2) and the functional part (16, 14) being mounted on a cover portion (40) at the bottom end of the filter cartridge and extending into the lateral recess in the filter medium when the filter cartridge is installed in the housing (1, 2), as in figs. 1 and 5.

18. With regards to claim 10, Pennebaker further discloses a filter cartridge comprising an annularly constructed filter medium (12) arranged between two axial end plates (6, 7) and the

filter medium (12) being provided with at least one lateral recess (in the vicinity of terminal 16 and at 15) for accommodating a functional part (i.e. terminal part 16 of electrical heating unit 14 or ground end of the heating unit 14) of a filter in which the filter cartridge is to be installed, as in fig. 1 and page 2.

19. With respect to claim 11, Pennebaker also discloses the two axial end plates (6, 7) being provided with notches aligned with the lateral recesses in the filter medium (12) so that the functional part (16 or ground upper end of the heating unit 14) could be inserted in an axial direction through the one of the end plates (7 or 6, respectively) into the lateral recesses in the filter medium (12), as in fig. 1.

Allowable Subject Matter

20. Claims 6 – 7 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

21. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art include Wilson et al. (US 4,565,629), Pennebaker (434) and Glebovsky et al. (800). However, none of these prior art, alone or in proper combination, have disclosed or rendered obvious a filter comprising all the limitation in the base claim 1 and further having the

limitation of the functional part being a probe of a water level sensor, as in claim 6 and having the limitation of the functional part being a suction tube of a liquid discharge, as in claim 7, wherein the functional part is being accommodated in a lateral recess in the filter medium.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 4,118,206 (Hagendoorn), 2,306,984 (Tolman), 4,565,629 (Wilson et al.), 3,279,607 (Michaelson) and 5,985,139 (Zoeller).

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:00 A.M. to 4:30 P.M..

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1723

25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Mso
M.S.O.
September 18, 2002

M. Savage
MATTHEW SAVAGE
PRIMARY EXAMINER